

## **REMARKS**

In the FINAL Office Action mailed June 28, 2000, the Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as obvious over *Nesbitt* in view of *Nakamura*. The Examiner then provisionally rejected claims 1-6 for obviousness-type double patenting over claims 1-8 of co-pending application 08/920,070. Also, the Examiner alleged that the Information Disclosure Statement filed March 27, 2000 failed to comply with 37 C.F.R. § 1.97(c) and 37 C.F.R. § 1.98(a)(2).

Applicant herein presents clarifying remarks and respectfully submits that claims 1-6 are in condition for allowance.

### **I. CLAIMS 1-6 ARE NOT OBVIOUS OVER *NESBITT* IN VIEW OF *NAKAMURA***

The Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as obvious over *Nesbitt* in light of *Nakamura*.

The present claims recite a second or outer layer or ply in the multi-layered golf balls comprised of a comparatively softer, *non-ionomeric thermoplastic or thermosetting elastomer such as polyurethane, a polyester elastomer or a polyesteramide*. Preferably, the inner layer or ply includes a blend of low acid ionomers and has a Shore D hardness of 60 or more and the outer cover layer comprises a polyurethane and has a Shore D hardness of about 45. The multi-layer golf balls of the invention can be of standard or enlarged size. The combination of *Nesbitt* in light of *Nakamura* neither teach nor suggest an outer cover layer of a three-piece ball having a non-ionomeric thermoplastic or thermosetting elastomer as recited in the present claims.

*Nesbitt*, the Examiner's primary reference, discloses a multi-layer golf ball which is produced by initially molding a first cover layer on a spherical core and then adding a second layer. The first layer is comprised of a hard, high flexural modulus resinous material such as type 1605 Surlyn® (now designated Surlyn® 8940). Type 1605 Surlyn® (Surlyn® 8940) is a sodium ion based low acid (less than or equal to 15 weight percent methacrylic acid) ionomer resin having a flexural modulus of about 51,000 psi. An outer layer of a comparatively

soft, low flexural modulus resinous material such as type 1855 Surlyn® (now designated Surlyn® 9020) is molded over the inner cover layer. Type 1855 Surlyn® (Surlyn® 9020) is a zinc ion based low acid (10 weight percent methacrylic acid) ionomer resin having a flexural modulus of about 14,000 psi.

The *Nesbitt* reference teaches that the hard, high flexural modulus resin which comprises the first layer provides for a gain in coefficient of restitution over the coefficient of restitution of the core. The relatively soft, low flexural modulus outer layer provides essentially no gain in the coefficient of restitution but provides for the advantageous "feel" and playing characteristics of a balata covered golf ball.

Unfortunately, however, while the balls shown in the examples of *Nesbitt* do exhibit some enhanced playability characteristics with slightly improved distance (i.e., enhanced C.O.R. values) over a number of other known multi-layered balls, the balls suffer from poor cut resistance and relatively short distance (i.e., lower C.O.R. values) when compared to two-piece, unitary cover layer balls. These undesirable properties make the ball produced in accordance with the specific examples of *Nesbitt* unacceptable by today's standards.

The present claims recite a multi-layer golf ball having a hard, low acid, inner layer and an outer layer of a relatively soft, non-ionomeric elastomer such as a polyurethane, a polyester elastomer or a polyester amide. As more particularly indicated in Example 4, use of non-ionomeric elastomers (Formulations 23-25) to produce the outer cover layer results in molded golf balls having softer compression, improved durability, higher spin, with similar C.O.R. values. The data indicates that a very good multi-layer ball can be made using non-ionomeric elastomers (i.e., polyurethane, etc.) as the material for the outer cover layers.

In addition, this application is directed to both standard size and oversize ball embodiments.

Furthermore, *Nakamura*, the Examiner's secondary reference, merely relates to a two-piece golf ball having a unitary cover comprised of a lithium neutralized ionomer resin having a Shore D hardness of at least 60. *Nakamura* is not directed to multi-layer golf ball technology and/or golf balls

having a soft, non-ionomeric elastomer outer cover and fails to address the particular characteristics of such a ball.

Lastly, an increase in cover thickness does not necessarily result in an increase in durability. Moreover, increasing the cover thickness of a multi-layered golf ball also effects such properties as weight, spin, C.O.R. (distance), compression, etc. As noted in the application, properties such as weights, etc. are strictly limited by the U.S.G.A. Thus, one can not merely increase the cover thickness to obtain enhanced durability of a regulation golf ball.

If one followed the teachings of the *Nesbitt* patent, one would be motivated to use an ionomeric material for the outer cover layer. See col. 2, lines 45-47 and col. 3, lines 35-40. That is directly opposite from the recitation in all pending claims that the outer cover layer comprise a non-ionomeric material. *Nakamura* fails to remedy the deficiencies of the *Nesbitt* patent. In fact, the *Nakamura* patent would also lead one away from the subject matter of the pending claims since *Nakamura* instructs that an ionomeric material be utilized for the outer cover layer. See col. 1, lines 5-6 and 40-43 for instance.

Consequently, Applicant respectfully submits that the present claims 1-6 are not merely a combination of the teaching of *Nesbitt* and *Nakamura*. Furthermore, the combination of *Nesbitt* and *Nakamura* will not result in the recited features of the present claims. Thus, reconsideration of the rejection of claims 1-6 is respectfully requested.

## **II. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION**

Upon allowance of claims 1-6, Applicant will submit one or more Terminal Disclaimers, as may be necessary, in one or both of the co-pending applications cited by the Examiner, U.S. Patent Application Serial Nos. 08/920,070 and 08/926,246 upon the indication of allowable subject matter.

## **III. INFORMATION DISCLOSURE STATEMENT**

The Examiner contended that the Information Disclosure Statement filed on March 27, 2000 failed to comply with 37 C.F.R. § 1.97(c) because it lacks a statement as specified in 37 C.F.R. § 1.97(e) and lacks a fee set forth in 37

C.F.R. § 1.17(p). Additionally, the Examiner stated that the Information Disclosure Statement failed to comply with 37 C.F.R. § 1.98(a)(2) requiring a legible copy of each U.S. and foreign patent; each publication which caused it to be listed; and all other information which caused it to be listed.

Under 37 C.F.R. § 1.97(c), Applicant, when filing an Information Disclosure Statement after the initial three-month period but before the final Office Action or notice of allowance, may either file a statement as specified under 37 C.F.R. § 1.97(e) or file the appropriate fee set forth in 37 C.F.R. § 1.17(p). Applicant submits that the proper fee of \$240.00 under 37 C.F.R. § 1.17(p) was submitted with the Information Disclosure Statement mailed on March 22, 2000. Applicant has fulfilled the requirement under 37 C.F.R. § 1.97(c) by paying the appropriate fee of \$240.00. Enclosed are copies of each of the following documents: (1) a copy of the Information Disclosure Statement, (2) a check stub, (3) a copy of the cancelled check, and (4) the filing receipt acknowledged by the U.S. Patent and Trademark Office on March 27, 2000, which are attached as Tab A. Applicant respectfully submits that if the U.S. Patent and Trademark Office did not receive the proper fee set forth in 37 C.F.R. § 1.17(p), that the appropriate amount be deducted from Deposit Account No. 06-0308. Therefore, Applicant respectfully submits that the requirements of 37 C.F.R. § 1.97(c) have been met.

Additionally, Applicant submits that copies of the references noted in the Information Disclosure Statement can be found in one or more of the prior applications from which the present application claims priority from, including U.S. Patent Application Serial Nos. 08/556,237 and 08/070,510. If any references cited are not found in the previous Information Disclosure Statement, Applicant shall provide a new copy of those references.

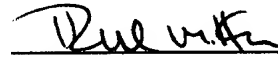
#### **CONCLUSION**

In view of the foregoing, Applicant respectfully submits that claims 1-6 are in condition for allowance. Applicant respectfully requests early notification of such allowance.

Respectfully submitted,

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